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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/978,416 | 10/16/2001 | Tadashi Ezaki | SONYJP 3.0-211 | 5305 |

530 7590 09/08/2004

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EXAMINER

WORJLOH, JALATEE

ART UNIT PAPER NUMBER

3621

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/978,416

Applicant(s)

EZAKI, TADASHI

Examiner

Jalatee Worjloh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-29 have been examined.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 14 and 27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to a process that does nothing more than manipulate an abstract idea. There is no practical application in the technological arts. All that is necessary to make a sequence of operational steps a statutory process within 35 U.S.C. 101 is that it be in the technological arts so as to be in consonance with the Constitutional purpose to promote the progress of "useful arts." *In re Musgrave*, 431 F.2d 882, 167 USPQ 280 (CCPA 1970). Also, a claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result: i.e. the method recites a step or act of producing something that is concrete, tangible and useful. *See AT&T v. Excel Communications Inc.*, 172 F.3d at 1358, 50 USPQ2d at 1452.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for

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patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-8, 11, 13-21, 28 and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent No. 6226618 to Downs et al.

Downs et al. disclose a receiver (i.e. "End-User Device") operable to receive content distributed in accordance with a rights management and protection method (i.e. "usage condition/use restriction"), an identification unit (i.e. "End-User Device") operable to identify said rights management and protection method for said received content (see col. 7, lines 48-55), and a rights processing unit (i.e. "End-User Device") operable to perform rights processing of said received content in accordance with said identified rights management and protection method (see col. 11, lines 40-52).

Referring to claims 2 and 15, Downs et al. disclose the rights management and protection method specifies indispensable item for purchasing and using content, said items including a content encryption method, a key distribution method, a content decryption method, a billing information and keys transmission method, recording medium control information, a mutual authentication method, an control information, a mutual authentication method, an analog protection system of macrovision or a copy generation management system, and viewing limitation information (i.e. "...copy restriction rules, wholesale price, and any business rules deemed necessary"), see col. 9, lines 34-36.

Referring to claims 3 and 16, Downs et al. disclose a plurality of types of rights management and protection modules (i.e. "purchase or rental"), wherein said rights processing unit selects a predetermined type of said rights management and protection modules based on

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said identified rights management and protection method in order to perform rights processing of said received content (see col. 59, lines 31-43).

Referring to claim 4, Downs et al. disclose a rights management and protection module acquiring unit (i.e. “End-User Device) operable to externally acquire a selected rights management and protection module based on said identified rights management and protection method, wherein said rights processing unit performs right processing of said received content by suing said selected rights management and protection module (see claim 1 above).

Referring to claim 5, Downs et al. disclose a creation unit (i.e. “metadata assimilation and entry tool) operable to automatically create a selected rights management and protection module based on said identified rights management and protection method, wherein said rights processing unit performs rights processing of said received content by suing said selected rights management and protection module (see col. 9, lines 32 & 33).

Referring to claim 11, Downs et al. disclose rights processing unit stores a log of rights processing of said received content (see col. 81, lines 34-39).

Referring to claims 6-8 and 19- 21, Downs et al. disclose a content storage unit (i.e. “End-User Device”) operable to: (1) store received content, (2) store received content before rights processing by said rights processing unit and (3) store received content after rights processing by said rights processing unit (see col. 11, lines 40-42).

Referring to claim 13, Downs et al. disclose said rights processing unit encrypts content after rights processing, and externally outputs said content (see col. 18 table, steps 124 & 125).

Referring to claims 14 and 27, Downs et al. disclose receiving content distributed in accordance with a rights management and protection method (i.e. “ usage condition/use

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restriction”), identifying the rights management and protection method for said received content (see col. 7, lines 48-55), and performing rights processing of said received content in accordance with said identified rights management and protection method (see col. 11, lines 40-52).

Referring to claim 17, Downs et al. disclose externally acquiring a selected rights management and protection module based on said identified rights management and protection method, wherein said rights processing unit performs right processing of said received content by suing said selected rights management and protection module (see claim 1 above).

Referring to claim 18, Downs et al. disclose automatically creating a selected rights management and protection module based on said identified rights management and protection method, wherein said rights processing unit performs rights processing of said received content by suing said selected rights management and protection module (see col. 9, lines 32 & 33).

Referring to claim 26, Downs et al. disclose encrypting content after rights processing, and externally outputs said content (see col. 18 table, steps 124 & 125).

Referring to claim 28, Downs et al. disclose means for storing a plurality of types of rights management and protection modules corresponding to respective rights management and protection methods (see col. 9, lines 48-60) and means for transmitting a selected one of the rights management and protection modules in response to a request containing information identifying the selected rights management and protection module (see col. 21, lines 30-42).

Referring to claim 29, Downs et al. disclose storing a plurality of types of rights management and protection (i.e. purchase or rental usage conditions), and means for selecting one of the rights management and protection modules based on identification information (see

col. 9, lines 48-60, col. 59, lines 41-43) and means for converting content by using the selected rights management and protection module (see col. 26, lines 9-19).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 9, 10, 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Downs et al. as applied to claims 1 and 14 above, and further in view of US Patent No. 6668246 to Yeung et al.

Downs et al. disclose said receiver is operable to receive content encrypted by a predetermined key, said receiver including a content storage unit operable to store content, and said rights processing unit is operable to decrypt said received encrypted content (see abstract, lines 1-3; col. 11, lines 40-42). Downs et al. do not expressly disclose the receiver operable to reencrypt said decrypted content using another key, and, thereafter, store said reencrypted content in said content storage unit. Yeung et al. disclose the receiver (i.e. "client platform") operable to reencrypt said decrypted content using another key, and, thereafter, store said reencrypted content in said content storage unit (see col. 9, lines 46-50). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the receiver of Downs et al. to reencrypt said decrypted content using another key, and, thereafter, store said reencrypted content in said content storage unit. One of ordinary skill in the

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art would have been motivated to do this because it minimizes piracy by providing additional security.

Referring to claim 10, Downs et al. disclose said receiver is operable to receive content encrypted by a predetermined key and said predetermined key is encrypted by a second key, said receiver including a content storage device unit operable to store content, and said rights processing unit being operable to decrypt said encrypted predetermined key (see abstract; col. 11, lines 40-42). Downs et al. do not expressly disclose the receiver operable to reencrypt said decrypted key using another key, and thereafter, store said reencrypted key, together with said encrypted content, in said content storage unit. Yeung et al. disclose the receiver (i.e. "client platform") operable to reencrypt said decrypted key using another key, and thereafter, store said reencrypted key, together with said encrypted content, in said content storage unit. see col. 9, lines 46-50). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the receiver of Downs et al. to reencrypt said decrypted key using another key, and thereafter, store said reencrypted key, together with said encrypted content, in said content storage unit. One of ordinary skill in the art would have been motivated to do this because it minimizes piracy by providing additional security.

Referring to claim 22, Downs et al. disclose the receiving step includes receiving content encrypted by a predetermined key, decrypting the encrypted content and storing the reencrypted content using another key (see abstract, lines 1-3; col. 11, lines 40-42). Downs et al. do not expressly disclose reencrypting the decrypted content using another key. Yeung et al. disclose reencrypting the decrypted content using another key (see col. 9, lines 46-50). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify

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step disclose by Downs et al. to include the step of reencrypting the decrypted content using another key. One of ordinary skill in the art would have been motivated to do this because it minimizes piracy by providing additional security.

Referring to claim 23, Downs et al. disclose receiving content encrypted by a predetermined key and receiving the predetermined key encrypted by a second key, decrypting the encrypted predetermined key and storing the reencrypted key together with the encrypted content (see abstract; col. 11, lines 40-42). Downs et al. do not expressly disclose reencrypting the decrypted key using another key. Yeung et al. reencrypting the decrypted key using another key. (see col. 9, lines 46-50). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Downs et al. to include the step of reencrypting the decrypted key using another key. One of ordinary skill in the art would have been motivated to do this because it minimizes piracy by providing additional security.

Referring to claim 24, Downs et al. disclose storing a log of rights processing of said received content (see col. 81, lines 34-39).

7. Claims 12 and 25 rejected under 35 U.S.C. 103(a) as being unpatentable over Downs et al. as applied to claims 1 and 14 above, and further in view of US Patent No. 6772344 to Chan.

Downs et al. disclose rights processing unit (see claim 1 above). Downs et al. do not expressly disclose the processing unit performs an analog protection system process on a playback signal of content after rights processing based on said identified rights management and protection method, and externally outputs said playback signal. Chan discloses the processing unit performs an analog protection system process on a playback signal of content after rights processing based on said identified rights management and protection method, and externally

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outputs said playback signal (see col. 10, lines 51-53). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Downs et al. to include an analog protection system process on a playback signal of content after rights processing based on said identified rights management and protection method, and externally outputs said playback signal. One of ordinary skill in the art would have been motivated to do this because it reduces piracy.

Referring to claim 25, Downs et al. disclose a receiving method (see claim 1 above). Downs et al. do not expressly disclose performing an analog protection system process on a playback signal of content after rights processing based on said identified rights management and protection method, and externally outputs said playback signal. Chan discloses the performing an analog protection system process on a playback signal of content after rights processing based on said identified rights management and protection method, and externally outputs said playback signal (see col. 10, lines 51-53). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Downs et al. to include the step of performing an protection system process on a playback signal of content after rights processing based on said identified rights management and protection method, and externally outputs said playback signal. One of ordinary skill in the art would have been motivated to do this because it reduces piracy.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 703-305-0057. The examiner can normally be reached on Mondays-Thursdays 8:30 - 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306 for Regular and After Final Actions and 703-746-9443 for Non-Official/Draft.

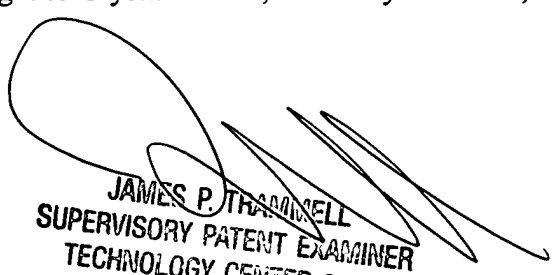
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Any response to this action should be mailed to:

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Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,
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September 1, 2004



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